

REMARKS

In the Office Action, claims 1 - 58 were noted as pending in the application, with claims 44 - 48 and 57 - 58 having been withdrawn by restriction. All elected claims, namely claims 1 - 43 and 49 - 56 were rejected in the Office Action. By this amendment, claims 1 and 49 have been amended, and no claims have been added or canceled. Thus, claims 1 - 43 and 49 - 56 are under prosecution in the application. The rejections of the Office Action are traversed below.

Rejection of Claims 35 and 36 under 35 USC §112

On pages 2 - 3 of the Office Action, claims 35 and 36 were rejected under 35 USC §112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. In particular, the feature, “contract list,” was asserted to be unclear. This rejection is respectfully traversed.

The list of performances comprises the products and services that the buyer wants to be delivered and/or performed (see specification at paragraph 42). The contract list of performances comprises the list of performances with the prices for each performance being included based on the prices stated in the selected bid (see specification at paragraph 54). The system generates the contract list of performances based on the list of performances and the prices stated in the selected bid (see specification at paragraph 54). The Applicants respectfully submit that the term, “contract list of performances,” is clearly disclosed in the specification; and, accordingly, the use of this term in claims 35 and 36 is clear and distinct. Withdrawal of the rejection of claims 35 and 36 under 35 USC §112 is respectfully requested.

Rejection of Claims 1 - 43 and 49 - 56 under 35 USC §101

On page 3 of the Office Action, claims 1 - 43 and 49 - 56 were rejected under 35 USC §101 because the claimed invention is allegedly directed to non-statutory subject matter. This rejection is respectfully traversed.

Independent claims 1 and 49, from which claims 2 - 43 and 48 - 56 respectively depend, have been amended herein to recite a “computer-implemented method” for fulfilling and managing an invitation to bid. Support for the amendment can be found in the originally-

filed specification at least at paragraphs 29 and 30 and Figure 2. Throughout the specification, the features recited in claims 1 and 49 are disclosed to be performed through a computer. For example, a list of potential bidders is selected by platform computer 21 from information archived in the descriptions database 27 (see paragraph 44). The bidders receive performance and bid-related information on their computers 25 and can calculate total prices for display on the bidders' monitors (see paragraph 45). Bids submitted by the bidders are received by the platform computer 21 for subsequent access from the buyers' computers 23 (see paragraphs 47 and 48). The Applicants respectfully submit that the application, as both disclosing and reciting the methodology as performed on a computer, is within the technological arts as required by the rules of the U.S. Patent and Trademark Office, including the requirements specified in *In re Bowman*, 61 USPQ2d 1669, 1671 (Bd of Pat Appeals and Intf 2001). Withdrawal of this rejection is respectfully requested.

Rejection of Claims 1 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 under 35 USC §102

On pages 3 - 4 of the Office Action, claims 1 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 were rejected under 35 USC §102 as being anticipated by U.S. Published Application No. 2002/0069154 to Fields. This rejection is respectfully traversed.

The Claimed Invention is Patentably Distinguishable Over Fields

The Applicants' claimed invention is directed to a method for fulfilling an invitation for bids of at least one performance. In particular, and reciting the features of claim1, there is claimed a bid invitation fulfillment method, including:

providing a database, comprising at least one performance description and at least one price description for each of a plurality of predetermined performances;

generating a list of performances desired by a buyer by selecting at least one of the predetermined performances from the database and by including the respective performance description in the list of performances;

forwarding the list of performances to a plurality of bidders;

receiving a bid from at least one of the plurality of bidders, each received bid including a bid price determined by the bidder and assigned to at least one

performance description of the list of performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder;

evaluating the received bids and selecting a bid from the bids received; and updating the database such that, for each performance of the generated list of performances for which a bid is selected, the price description in the database corresponding to said performance is modified to reflect the selected bid.

The recited method includes generating a list of performances desired by a buyer, forwarding the list of performances to a plurality of bidders, receiving a bid from at least one of the plurality of bidders, evaluating the received bids and selecting a bid, and updating a price description in a database based on the selected bid.

The Office Action asserts that Fields fully anticipates the method recited in claim 1 by disclosing each of the claimed features. The Applicants respectfully disagree. Fields discloses a system for building requests for proposals (RFP) for legal services for acceptance by attorneys (Fields at abstract; par 47). The inventor/client uses the system to build a request for proposal for submission to attorneys who are registered in the system (pars 70, 87). The request for bid includes all costs and charges for the request, as generated by the system (par 77, 78; Figs. 15 & 21). The attorney can accept, reject or delete the request for proposal (par 88).

The Office Action cites to Fields at page 7, par 90 as allegedly disclosing, as required by 35 USC §102, each and every feature recited in claim 1. The Applicants respectfully assert that the Office Action's reliance on Fields is misplaced. The present claimed bid invitation fulfillment method recites, for example, "forwarding a list of performances to the plurality of bidders" and "receiving a bid from at least one of the plurality of bidders, each received bid including a bid price determined by the bidder." Fields discloses no such feature. Instead, the bid prices of Fields are determined by the RFP system itself, based on fee grids internal to the system (par 77, 78, 80; Figs. 15 & 21). The bidder/attorney of Fields does not determine the bid prices -- he/she merely accepts, rejects, or deletes the received RFP (par 88). The relied-upon paragraph 90 of Fields merely discloses a back end system which can alter the fee grids of the system based on the pre-priced, accepted requests for proposals.

Claim 1 also recites “evaluating the received bids and selecting a bid from the bids received.” The system of Fields discloses no such feature. Instead, the Fields system merely notifies the client by email that one or more attorneys has responded to the request for proposal, whereupon the client can view the list of responding attorneys. “The client then has the sole discretion as to whether to contact the attorney or agent.” Fields at par 88, 89.

It is respectfully submitted that Fields fails to disclose each of the features recited in claim 1; and, therefore, Fields cannot reasonably be said to anticipate Applicants' claimed invention. Accordingly, claim 1 is believed to be patentably distinguishable over the Fields document, and it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 2 - 43 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Field document. For example, claim 17 specifies receiving several bids from each of several bidders, with the last bid received from each bidder being used for bid evaluation and selection, which is neither taught nor suggested by Fields. Fields is expressly limited to accepting, rejecting or deleting a request for proposal (Fields at par 88) and is silent regarding submitting several bids in response to an invitation to bid.

As a further example, claim 10 recites that the database comprises prices independent of the region in which the predetermined performance is to be effected, and wherein the database further comprises at least one regionally dependent price correction term for a plurality of regions in which the predetermined performance is to be effected. Claim 11 recites utilizing the regionally independent prices and the regional dependent price correction term for determining an estimated price. The Office Action implicitly admits that Fields discloses no such features, but the Office Action also asserts that such features would be inherent given a price term independent of region and a regional price. However, for this particular feature to be inherent, it must necessarily be present for determining an estimated regional price (see MPEP §2112). In contrast to the assertions of the Office Action, Fields discloses that such a feature is not required, and therefore is not inherent, for determining regional prices. Fields can determine regional pricing based on fee grids which include both regional and national (independent of region) fees, with no disclosure of a regionally dependent price correction term (see Fields at 78, 80, 88).

The Applicants respectfully note that the present Office Action has relied on a

published application to Fields to reject claims 1 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 under 35 USC § 102, but has presented no analysis regarding where each of these documents fully anticipates the features recited in claims 2 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43, contrary to the requirements of 37 CFR § 1.104(c); MPEP § 706. In fact, the Office

Action is completely silent regarding why or how Fields can possibly anticipate the features recited in claims 2, 7 - 9, 13 - 15, 18, 19, 26, 33, and 38 - 41.

Therefore, for at least these reasons and the reasons set forth above with respect to claim 1, it is submitted that claims 2 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 patentably distinguish over the Fields document and withdrawal of the rejection of claims 2 - 3, 7 - 10, 13 - 15, 18, 19, 26, 33, 38 - 41, and 43 is respectfully requested.

Rejection of Claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42 under 35 USC §103

On pages 3 - 7 of the Office Action, claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42 were rejected under 35 USC § 103 as being unpatentable over U.S. Published Application No. 2002/0069154 to Fields. This rejection is respectfully traversed.

The Claimed Invention is Patentably Distinguishable Over the Cited Document

The Applicants' claimed invention is directed to a method for fulfilling an invitation for bids of at least one performance. Additional features of the Applicants' claimed invention are recited in claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42. The Office Action admits that Fields fails to disclose any of the features recited in claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42. The Office Action then proceeds to assert, without support, that the features recited in each of these claims are old and well known in the art. The Applicants respectfully disagree and request the Examiner provide support for his assertion for each of the recited features, in accordance with MPEP §2144.03.

For example, the Office Action asserts that it would have been well known, in view of Fields, to use a regionally dependent price correction term to determine a regional price. However, Fields expressly discloses fee grids comprising both regional pricing and national (regionally independent) pricing (par 77, 80). Therefore, there would have been no need to modify Fields to provide for regional pricing in the manner suggested by the Office Action

and as recited in claim 11 herein. The Office Action proceeds to assert that the features of claim 11 would have been an obvious design choice because, in the unsupported assertion of the Office Action, “it does not appear that this particular method of determining regional prices solves a particular problem or is for a specific purpose.” However, whether a feature solves a particular problem or is for a specific purpose does not constitute grounds for rejection under 35 USC §103. See MPEP §2143.

As a further example, claim 35 recites automatically generating a contract list of performances after selecting the bid. As discussed above regarding the rejection under 35 USC §112, the contract list of performances is the list of performances with the prices for each performance being included based on the prices stated in the selected bid. Such a feature would not have been obvious in view of Fields because the Fields system generates the prices for the list of performances before the request for proposals are sent to the attorneys and, therefore, before any attorney is selected for performing the work (see Fields at 77, 78, 87, 88).

For the reasons discussed above, claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42 are believed to be patentably distinguishable over Fields. Accordingly, it is respectfully requested that the rejection of claims 4 - 6, 11, 12, 16, 20, 21, 34 - 36, and 42 be withdrawn.

Rejection of Claims 17 and 27 - 32 under 35 USC §103

On pages 7 - 8 of the Office Action, claims 17 and 27 - 32 were rejected under 35 USC § 103 as being unpatentable over U.S. Published Application No. 2002/0069154 to Fields in view of U.S. Published Application No. 2002/0077954 to Slaight et al.. This rejection is respectfully traversed.

The Claimed Invention is Patentably Distinguishable Over the Cited Documents

The Applicants' claimed invention is directed to a method for fulfilling an invitation for bids of at least one performance. Additional features of the Applicants' claimed invention are recited in claims 17 and 27 - 32. The Office Action asserts that the Fields and Slaight et al documents disclose all of the features recited in claims 17 and 27 - 32; but the Office Action fails to disclose where each of these documents fully discloses the features recited in claims 17 and 28 - 32, contrary to the requirements of 37 CFR §1.104(c); MPEP §§706,

2144.08.

Slaight et al. discloses an online electronic auction system, where the system receives multiple bids on at least one product from a plurality of vendors. (Slaight et al. at abstract; par 4). The system begins with the purchaser selecting one or more products to be purchased that will become the basis for the auction (par 60). A request for proposal (RFP) is developed and transmitted to the selected vendors (par 66, 67). The vendors receive the RFP, prepare a response, and send the response back to the purchaser (par 67). Based on the vendor responses, a third list of vendors is selected to participate in the auction (par 68). The auction then commences among the vendors on the third list (par 72). Competition during the auction is facilitated by providing pricing feedback to the vendors during the auction (par 5, 120).

The Office Action admits that the Fields document fails to disclose the features recited in claims 17 and 28 and introduces the Slaight et al. document to allegedly disclose these missing features. While teachings of several documents may be combined to render a claimed invention obvious, there must be a motivation or suggestion in the documents relied upon to make the specific combination. The Applicants respectfully assert that no suggestion or motivation exists in either Fields or Slaight et al. to combine the request for proposals system of Fields with the electronic auction system of Slaight et al. in the manner suggested by the Office Action. The Office Action asserts on page 7 that it would have been obvious to modify the system of Fields with the feedback disclosed in Slaight et al. and to allow repeated bids in order to assist the bidder in fixing problems in his bid. However, the bidder/attorney of Fields merely accepts, rejects or deletes the RFP (Fields at par 88). The pricing of Fields is determined by the RFP system prior to sending the pricing RFP to the bidder/attorney for possible acceptance. Therefore, any problems in the pricing is within the RFP system, which is outside the control of the bidder. Furthermore, the concept of repeated bids by the bidder in Fields makes no sense because the bidder/attorney in Fields merely accepts, rejects or deletes the RFP that has been sent to the bidder/attorney. Not only has the Office Action failed to cite to any portion of either Fields or Slaight et al. for providing a suggestion or motivation for combining the references in the manner suggested by the Office Action, the proposed combination would be inoperable in view of Fields because the bidder/attorney of Fields does not submit any pricing proposals to the purchaser.

The Office Action further asserts, without citation or support, that the features of

claims 28 - 30 are disclosed in the Fields document. The Office Action further admits that the features of claim 27 are not disclosed in Fields, but asserts that the features of claim 27 are disclosed by Slaight et al. in Fig. 33. However, the Applicants respectively submit that if Fields fails to disclose the synthetic price as recited in claim 27, then it cannot reasonably be said that the Fields document would then disclose the synthetic price features disclosed in claims 28 - 30, which depend from claim 27, as asserted in the Office Action. The Applicants further submit that Fig. 33 of Slaight et al. discloses a pricing feedback graph to the vendors, comparing the vendor's best bid against the current bid for the product, which is not the synthetic price feature recited in claim 27 herein.

For the reasons discussed above, claims 17 and 27 - 32 are believed to be patentably distinguishable over Fields and Slaight et al, either taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claims 17 and 27 - 32 be withdrawn.

Rejection of Claims 22 - 25, 37, and 49 - 56 under 35 USC §103

On pages 8 - 9 of the Office Action, claims 22 - 25, 37, and 49 - 56 were rejected under 35 USC § 103 as being unpatentable over U.S. Published Application No. 2002/0069154 to Fields in view of U.S. Published Application No. 2001/0051913 to Vashistha et al. This rejection is respectfully traversed.

The Claimed Invention is Patentably Distinguishable Over the Cited Documents

The Applicants' claimed invention is directed to methods for managing and fulfilling an invitation for bids of at least one performance. Additional features of the Applicants' claimed invention are recited in claims 22 - 25, 37, and 49 - 56. The Office Action asserts that the Fields and Vashistha et al documents disclose all of the features recited in claims 22 - 25, 37, and 49 - 56; but, with the exception of claims 54 - 56, the Office Action fails to disclose where each of these documents fully discloses the features recited in these claims, contrary to the requirements of 37 CFR §1.104(c); MPEP §§706, 2144.08.

Vashistha et al. discloses a method and system for facilitating the outsourcing of information technology projects and services (Vashistha et al. at abstract; par 28). Buyers and providers both register with the outsourcing system (par 36, 46). The buyer develops a

request for proposal (RTP) and submits it to the outsourcing system for matching against the registered provider information (par 37, 38, 53, 58). Based on the matching between the RTP and the provider information, a qualified list of providers is developed; and the RTP's are sent to the selected providers (par 38, 40, 63, 65). The selected providers respond with bids, and the outsourcing system evaluates the bids and provides the buyer with a selection matrix (par 40, 41, 66, 68). The buyer then selects a winning provider (par 77, 78).

The Office Action asserts that Fields discloses each of the features recited in claims 37 and 49, with the exception of the automatic bid selection of claim 49. The Vashistha et al. document is introduced to allegedly disclose the automatic bid selection feature. The Applicants respectfully submit that the Office Action's reliance on both Fields and Vashistha et al. is misplaced. First, as discussed above regarding claim 1, Fields discloses that prices are determined within the RFP system, and the bidder/attorneys merely accept, reject or delete the received RFP's. Accordingly, Fields at least fails to disclose the claim 49 feature of "receiving a bid submitted from at least one of the plurality of bidders, wherein each submitted bid includes a price assigned to at least one of the distributed list of performances." Further, the system of Vashistha et al. discloses that it is the buyer, not the outsourcing system, that selects the winning bid (see Vashistha et al. at par 77, 78).

Claims 22 - 25 and 37 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Fields or Vashistha et al. documents. Therefore, for at least the reasons set forth above with respect to claim 1, it is submitted that claims 22 - 25 and 37 patentably distinguish over the Fields and Vashistha et al. documents, either taken alone or in combination, and withdrawal of the rejection of claims 22 - 25 and 37 is respectfully requested.

Claims 50 - 56 depend from claim 49 and include all the features of claim 49 plus additional features which are not taught or suggested by the Fields or Vashistha et al. documents. Therefore, for at least the reasons set forth above with respect to claim 49, it is submitted that claims 50 - 56 patentably distinguish over the Fields and Vashistha et al. documents, either taken alone or in combination, and withdrawal of the rejection of claims 50 - 56 is respectfully requested.

While teachings of several documents may be combined to render a claimed invention obvious, there must be a motivation or suggestion in the documents relied upon to make the

specific combination. The Applicants respectfully assert that no suggestion or motivation exists in either Fields or Vashistha et al. to combine the request for proposals system of Fields with the outsourcing system of Vashistha et al. in the manner suggested by the Office Action. The Office Action asserts on pages 8 and 9 that it would have been obvious to modify the system of Fields with the teachings of Vashistha et al. to reduce the amount of manual labor required in selecting a bid and to provide a deviation in order to assist in determining the best bid. However, both Fields and Vashistha et al. disclose that the client/buyer manually selects the bidder/attorney/provider. Accordingly, the manual selection teachings of Vashistha et al. would not reduce the manual labor required in the Fields system to select a bid. Similarly, since neither Fields nor Vashistha et al. discloses determining a deviation from the ideal price, it cannot reasonably be said that such a feature would have been obvious in view of the teachings of Fields and Vashistha et al., as asserted in the Office Action. Further, the Office Action has failed to cite to any portion of either Fields or Vashistha et al. for providing a suggestion or motivation for combining the references in the manner suggested by the Office Action.

For the reasons discussed above, claims 22 - 25, 37, and 49 - 56 are believed to be patentably distinguishable over Fields and Vashistha et al, either taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claims 22 - 25, 37 and 49 - 56 be withdrawn.

Summary

It is submitted that none of the documents, either taken alone or in combination, teach the claimed invention. Thus, claims 1 - 43 and 49 - 56 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,
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